

REMARKS

Upon entry of the proposed amendment, claims 1-22 and 41-58 are pending.

Restriction Requirement

Applicants affirm the provisional election made, with traverse, via a telephonic conversation on 1/11/2005 to prosecute the invention of Group I, claims 1-22 and 41-58. Applicants further request reconsideration of the restriction requirement.

Restriction is only proper if the restricted inventions are independent and patentably distinct (MPEP 803). Applicants respectfully traverse the restriction requirement and submit that the restriction is improper. Applicants' agent sees no basis in the restriction requirement for alleging Groups I through XII are distinct. Merely citing different classifications should not be treated as a conclusion that the invention is patentably distinct. In fact, claims 1-74 all involve a single inventive concept for which a single patent should issue, that is, they deal with processes leading to the preparation of the same final product – entecavir.

Accordingly, in view of the foregoing, reconsideration and withdrawal of the requirements for restriction and election are requested.

35 U.S.C. § 112, second paragraph

Claims 1-22, 41-49, and 51-58 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

1. The Examiner states that Applicant acts improperly to be his or her own lexicographer by defining the alkyl group (or other organic groups) to include substituted alkyl (or other organic groups). Applicants respectfully submit that the Examiner's position is not well based. It is a well-established that an inventor is free to be his or her own lexicographer and may use terms inconsistent with one or more of their ordinary meanings. See *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1347 (Fed. Cir. 2003). An applicant, acting as a lexicographer, may even define "black" as "white." See *Hormone Research Found., Inc. v. Genentech, Inc.*, 904

F.2d 1558, 1563 (Fed. Cir. 1990). Here, Applicants clearly define the term “alkyl” to include substituted alkyl groups in the specification. See pages 4-5 of the present application. Similarly, Applicants unambiguously define the terms such as “allyl,” “aryl,” “benzyl,” etc. to include, respectively, substituted allyl, substituted aryl, substituted benzyl, etc.

Nonetheless, to expedite the prosecution of the application and also considering the fact that the Examiner’s suggested amendment (i.e., an organic group such as alkyl may be optionally substituted) does not change the scope of the claimed invention, Applicants have amended the specification according to the Examiner’s suggestion.

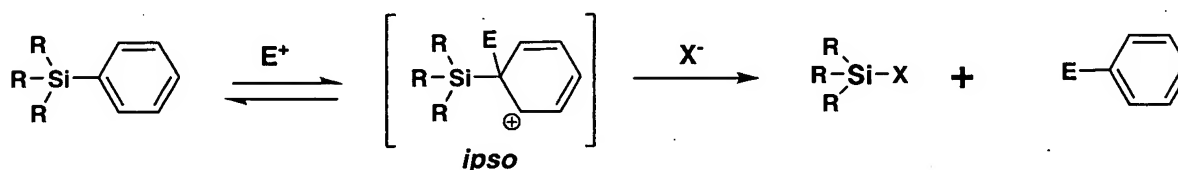
2. The Examiner states that the abbreviation “Bn” is not defined. Applicants respectfully submit that “Bn” is defined as benzyl on page 2 of the specification.

3. Similarly, “MOP” in claim 6 is defined on page 3, line 10; “KHMDS” in claim 9 is defined on page 3, line 2; the last three terms in claim 15 “TMOF,” “TEOF,” and “TiPOF” are also defined on page 3; “BHT” in claim 16 is defined on page 2, line 11; “TFA” is defined on page 3, line 27, of the present application.

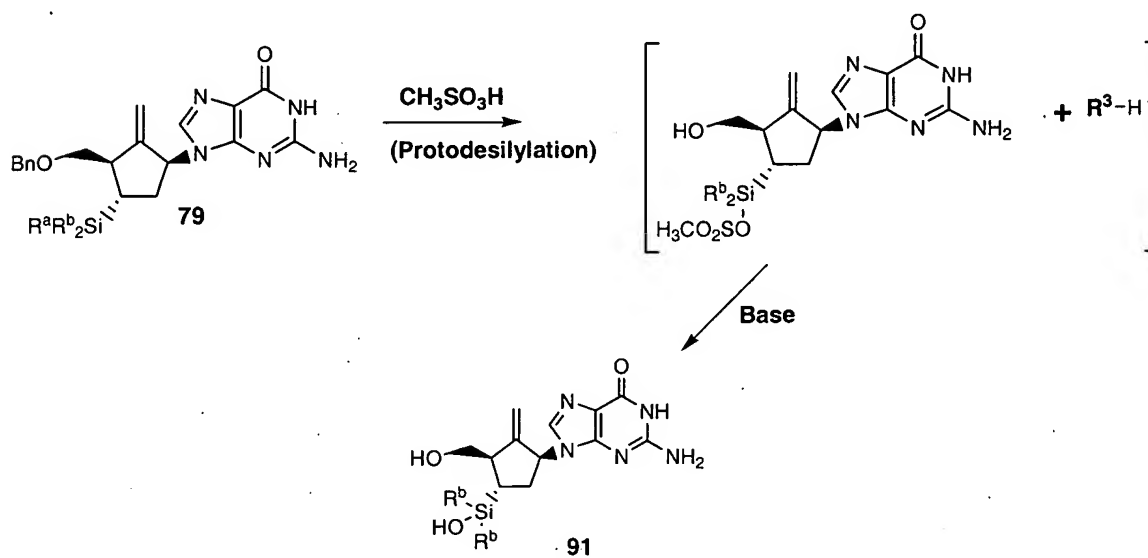
4. The Examiner states that the term “converting” is indefinite and unduly functional. Applicants respectfully traverse. In using the term “converting” for a chemical process, Applicants clearly define a starting material and a final product for such process with definiteness and precision. Thus, one person of ordinary skill in the chemical art understands that this particular process achieves the transformation from the starting material to the final product as stated in the claims. To expedite the prosecution of the application, however, Applicants have amended the term of “converting” in the claims.

5. The Examiner states that the term “protodesilylation” (or “protodesilylating”) is not clear. Applicants respectfully submit that the term “protodesilylation” is well known in the art (“protodesilylating” is simply a verb form of “protodesilylation”). See, e.g., Fleming et al., “Silyl-to-Hydroxy conversion in Organic Synthesis,” *Chemtracts – Organic Chemistry*, Vol. 9, pp.1-64 (1996); Jones et al., “The Oxidation of the Carbon-Silicon Bond,” *Tetrahedron*, Vol., 52, No.22, pp.7599-7662 (1996). For example, the conversion of the carbon-silicon bond in a dimethylphenyl substituted silicon compound to a carbon-hydroxyl bond of the same compound involves two steps. The

“protodesilylation” here relates to the first step of the conversion in which the silicon-aryl bond is broken by an electrophilic reagent ($E+X^-$). At the end of the transformation, $E+$ is attached to the departing phenyl ring and the X^- resides with the silicon. The cleavage of the silicon-aryl bond can be treated as a classical electrophilic aromatic substitution, via an *ipso* substitution, to the expected electrophilic-substituted arene, and in addition, the corresponding R_3Si-X compound.



Additionally, the specification of the instant application clearly defines what a protodesilylation step achieves in a chemical transformation. For example, in Scheme 4 on page 20 of the present application, compound **79** is converted to compound **91** via protodesilylation where R^a is replaced with OH (here, R^a can be phenyl, allyl, alkylphenyl, alkoxyphenyl, etc.). Specifically, compound **79** is treated with methanesulfonic acid followed by strong base. Under these conditions, not only debenzoylation of the primary benzyl ether takes place but also protodesilylation at the silicon atom occurs as shown below:



6. The Examiner states that the term "weak acid" is vague. Applicants respectfully submit that one skilled in the art understands what a weak acid means. To expedite the prosecution of the application, however, Applicants have deleted the reference to the term of weak acid in the claims and thus making the objection moot.

7. The Examiner states claim 11 lack a final period. Applicants have added a final period to claim 11.

In view of the amendments and remarks, Applicants respectfully request that the §112, second paragraph rejection be withdrawn and the application be allowed to issue. Early notification of such action is earnestly solicited.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
(609) 252-6457

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Henry H. Gu
Agent for Applicants
Reg. No. 55,227